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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,927	01/04/2001	Randy L. Prakken	SWIF 1981	3848
7812	7590	07/14/2004	EXAMINER	
SMITH-HILL AND BEDELL 12670 N W BARNES ROAD SUITE 104 PORTLAND, OR 97229			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,927

Applicant(s)

PRAKKEN ET AL.

Examiner

Cristina O Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed 8 April 2004. Claims 1,3,4,6,12, 14,17 have been amended. Claims 1-26 are pending in this case.

#### ***Response to Arguments***

2. Applicant's arguments filed 8 April 2004 have been fully considered but they are not persuasive. Applicant argues, with respect to claims 1-11 and 12-22 that the cited references do not disclose a file that is transmitted by licensed software. Attention is directed to Wyatt (US 6,041,411A) at, e.g. Col 1 ln 54 – col 2 ln 55. Applicant further argues, with respect to claims 23-26 that Wyatt does not teach or discloses a third means for embedding an encoded license in the data file and for forwarding said data file to a second means such that the encoded license indicates the data file as having been forwarded by the third means. Attention is directed to Wyatt (US 6,041,411A) at, e.g. Col 2 ln 35-55.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt (US 6,041,411A) in view of Mueller et al (US 6,263,442 B1).
5. Regarding claim 1 –

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Wyatt discloses for a data file distribution and processing system including server software running on a source computer for sending data files to a destination computer via a network link between the source computer and the destination computer, and including processing software running on the destination computer for processing each data file forwarded thereto from said server software to carry out an action, a method for preventing the processing software running on the destination computer from processing data files forwarded to the destination computer other than from the server software, the method comprising the steps of including within the server software running on the source computer license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network link; and adapting said processing software executed by said destination computer so that it processes each received data file to carry out said action only when the received data file contains the embedded license stamp, wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software (Col 1 ln 54 – col 2 ln 55).

6. Regarding claim 2 –

Wyatt discloses the method in accordance with claim 1 wherein said encoded license stamp comprises a code identifying said source computer (Col 5 ln 58 – col 6 ln 14).

7. Regarding claim 3 –

Wyatt discloses the method in accordance with claim 1 wherein said each data file, including its embedded stamp is a print file defining a document in a format suitable for directly causing a printer to print said document (Col 15 ln 40-60).

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8. Regarding claim 4 –

Wyatt discloses the method in accordance with claim 3 wherein said license stamping means embeds said encoded license stamp into the data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (Col 15 ln 50-60).

9. Regarding claim 5 –

Wyatt discloses the method in accordance with claim 3 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (Col 10 ln 6-29).

10. Regarding claim 6 –

Wyatt discloses the method in accordance with claim 2 wherein said action carried out by said processing software comprises causing said printer to print said document (Col 15 ln 40-60).

11. Regarding claim 7 –

Mueller discloses the method wherein said data file defines a sound and wherein said action carried out by said processing software comprises an initiating said sound (col 2 ln 30-40).

12. Regarding claim 8 –

Mueller discloses the method wherein said data file defines a video image and wherein the action carried out by said processing software comprises initiating a display of said video image (col 2 ln 55-65).

13. Regarding claim 9 –

Wyatt discloses the method in accordance with claim 1 wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code indicating said value of said attribute, and wherein the method further comprises the step of adapting the processing software to process each received data file to determine a value of said attribute of each data file received, and to refrain from processing the received data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute matching the value of said attribute determined by said processing software (col 8 ln 19-37).

14. Regarding claim 10 –

Wyatt discloses the method in accordance with claim 9 wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means (Col 7 ln 37-50).

15. Regarding claim 11 –

Wyatt discloses the method in accordance with claim 1 wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file (Col 8 ln 4 – 18).

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16. It would be obvious to a practitioner of ordinary skill in the art to combine the teachings of Wyatt and Mueller in order to obtain greater flexibility and security in the licensing of data files.

17. Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt (US 6,041,411A) in view of Mueller et al (US 6,263,442 B1).

18. Regarding claim 12 –

Wyatt discloses a data file distribution and processing system comprising:  
a source computer; a destination computer; and network means for conveying data files from said source computer to said destination computer, wherein said source computer executes server software for sending data files to the destination computer via said network means, wherein said destination computer executes processing software for processing each data file forwarded thereto from said server software to carry out an action, wherein said server software includes license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network means, wherein said processing software processes each received data file to carry out said action only when the received data file contains the embedded license stamp, wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software (Col 1 In 54 – col 2 In 55).

19. Regarding claim 13 –

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Wyatt discloses the data file distribution and processing system in accordance with claim 12 wherein said encoded license stamp comprises a code identifying said source computer (Col 5 ln 58 – col 6 ln 14).

20. Regarding claim 14 –

Wyatt discloses the data file distribution and processing system in accordance with claim 12 wherein each said data file, including its embedded data stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document (Col 5 ln 58 – col 6 ln 14).

21. Regarding claim 15 –

Wyatt discloses the data file distribution and processing system in accordance with claim 14 wherein said license stamping means embeds said encoded license stamp into the data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (Col 15 ln 50-60).

22. Regarding claim 16 –

Wyatt discloses the data file distribution and processing system method in accordance with claim 14 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (Col 10 ln 6-29).

23. Regarding claim 17 –

Wyatt discloses the data file distribution and processing system in accordance with claim 13 wherein said action carried out by said processing software comprises causing said printer to print said document (Col 15 ln 40-60).



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24. Regarding claim 18 –

Mueller discloses the data file distribution and processing system wherein said data file defines a sound and wherein said action carried out by said processing software comprises a initiating said sound (col 2 ln 30-40).

25. Regarding claim 19 –

Mueller discloses the data file distribution and processing system wherein said data file defines a video image and wherein the action carried out-by said processing software comprises initiating a display of said video image (col 2 ln 55-65).

26. Regarding claim 20 –

Wyatt discloses the data file distribution and processing system in accordance with claim 12 wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code indicating said value of said attribute, and wherein the method further comprises the step of adapting the processing software to process each received data file to determine a value of said attribute of each data file received, and to refrain from processing the received data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute matching the value of said attribute determined by said processing software (col 8 ln 19-37).

27. Regarding claim 21 –

Wyatt discloses the data file distribution and processing system in accordance with claim 20 wherein the data file processed by said license stamping means consists of a

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plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means (Col 7 ln 37-50).

28. Regarding claim 22 –

Wyatt discloses the data file distribution and processing system in accordance with claim 12 wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file (Col 8 ln 4 – 18).

29. It would be obvious to a practitioner of ordinary skill in the art to combine the teachings of Wyatt and Mueller in order to obtain greater flexibility and security in the licensing of data files.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

30. Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Wyatt (US 6,041,411A).

31. Regarding claim 23 –

Wyatt discloses a data file distribution and processing system comprising:

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first means for providing a data file; second means for receiving the data file, for checking the data file to determine whether the data file contains an encoded license, and for thereafter processing the data file only when the data file contains the encoded license; and third means for receiving the data file provided by said first means, for embedding said encoded license in the data file, and for forwarding said data file with the encoded license embedded therein to said second means, such that said encoded license indicates said data file as having been forwarded by said third means (Col 1 In 54 – col 2 In 55).

32. Regarding claim 24 –

Wyatt discloses the data file distribution and processing system in accordance with claim 23 further comprising a printer, wherein said data file provided by said first means is a print file suitable as input to said printer for instructing said printer to print a document, and wherein said third means processes said data file by displaying an image of said document and by transmitting said data file as input to said printer such that said printer prints said document in response to said print file (Col 1 In 54 – col 2 In 55).

33. Regarding claim 25 –

Wyatt discloses the data file distribution and processing system in accordance with claim 23 wherein said second means embeds said encoded license into the data file in such a way that the printer ignores the encoded license when printing said document (Col 15 In 40-60).

34. Regarding claim 26 –

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Wyatt discloses the data file distribution and processing system in accordance with claim 23 wherein said embedded license includes a code identifying a licensee (Col 7 In 37-50).

35. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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